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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,040	02/06/2004	Justin T. Ernst	060621-0703	4994

30542 7590 06/19/2007  
FOLEY & LARDNER LLP  
P.O. BOX 80278  
SAN DIEGO, CA 92138-0278

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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06/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/774,040

Applicant(s)

ERNST ET AL.

Examiner

Rosalynd Keys

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-41 and 43-85 is/are pending in the application.
- 4a) Of the above claim(s) 5, 24, 33, 35, 40, 41, 44, 46, 49, 61-65 and 67-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-23, 25-32, 34, 36-39, 43, 45, 47, 48, 50-60 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-41 and 43-85 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/30/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 2-41 and 43-85 are pending.  
Claims 2-4, 6-23, 25-32, 34, 36-39, 43, 45, 47, 48, 50-60, and 66 are rejected.  
Claims 5, 24, 33, 35, 40, 41, 44, 46, 49, 61-65 and 67-85 are withdrawn from further consideration.  
Claims 1, 42 and 86 are cancelled.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on March 30, 2007 has been considered by the examiner.

### ***Oath/Declaration***

3. The new oath/declaration filed March 30, 2007 is in compliance with 37 CFR 1.67(a).

### ***Election/Restrictions***

4. Applicant's election without traverse of Group I claims 2-4, 6-23, 25-32, 34, 36-39, 43, 45, **47, 48**, 50-53, 56-60, and 66 and species Compound No. 5 in example 11 in the reply filed on May 30, 2007 is acknowledged.
5. Claims 5, 24, 33, 35, 40, 41, 44, 46, 49, 61-65 and 67-85 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species or invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 30, 2007.
6. The restriction requirement with regard to claims 47 and 48 is withdrawn, since they read upon the elected subject matter.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 2-4, 6-23, 25-32, 34, 36-39, 43, 45, 47, 48, 50-60, and 66 are rejected under 35 U.S.C. 102(a) as being anticipated by Hamilton et al. (US 2003/00088882 A1).

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Hamilton et al. disclose the instant claim compound and pharmaceutical composition

(see entire disclosure, in particular compound figure 4).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2, 9-15, 17-20, 25, 36-39, 43, 45, 47, 48, 50-55 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Connor et al. (WO 99/32433).

Connor et al. disclose the instant claim compound and pharmaceutical composition

(see entire disclosure, in particular compound IV on pages 21-22).

### ***Response to Arguments***

10. Applicant's arguments filed March 30, 2007 have been fully considered but they are not persuasive. Even with the claimed amendments the instant compound having formula I is anticipated by Hamilton et al. and Connor et al. (see rejections above).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

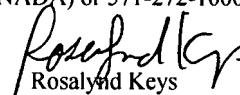
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, W & F 5:30-7:30 am & 1-5 pm; T & Th 5:30 am-4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richter Johann can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosalyn Keys  
Primary Examiner  
Art Unit 1621

June 11, 2007